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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,305	04/10/2001	Robert A. Kronenberger	130.00095	2960

7590

07/26/2004

WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER
SUITE 3800
500 WEST MADISON STREET
CHICAGO, IL 60661

EXAMINER

THOMPSON JR, FOREST

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,305

Applicant(s)

KRONENBERGER, ROBERT A.

Examiner

Forest Thompson Jr.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-25 have been examined.

Drawings

2. New corrected drawings are required in this application because the drawings are considered DRAFT copies (e.g., rough sketches by examiner. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Knight (U.S. Patent No. 6,344,853).

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claims 1, 11: Knight teaches:

- over the computer network, providing the potential customer with a display with at least one display icon representing an object having the predetermined three-dimensional shape (fig. 3B [142a]);
- over the computer network, providing the potential customer with a user input for a design element selected by the user to be included on said object (fig. 3C [142c, 144']); and
- over the computer network, providing the potential customer with a display of the user selected design element on the object represented by the selected display icon (fig. 3C [142c, 144']; fig. 3D [142a, 144']).

Claim 2: Knight teaches a plurality of display icons are provided, and further comprising providing an input for said user to select one of said plurality of display icons

prior to providing said display of the user selected design element on the object represented by the selected display icon (fig. 3A [132, 133, 136]; col. 5 lines 32-39).

Claim 3: Knight does not explicitly teach said display icons are different perspective views of a predetermined three-dimensional shape of one object. However, Knight does teach (col. 8 lines 53-60) that *It is contemplated that the present invention may include the capability to permit the purchaser to choose which of the available place holders where the selected logo 144 may be positioned relatively with respect to the promotional product 142*. This teaching encompasses applicant's claimed aspect.

Claim 4: Knight teaches said display icons represent different objects (fig. 3B [142d, 142a]).

Claim 5: Knight teaches said object is a cap (fig. 3B [142a]).

Claim 6: Knight teaches said design element is text (fig. 2A [50, 52, 54], col. 6 line 49 – col. 7 line 9).

Claim 7: Knight teaches said design element may be selected from among a plurality of design elements, where user selected text may be included in at least one of said plurality of design elements (fig. 3E [150]; col. 9 lines 30-41).

Claim 8: Knight teaches providing a user input for selecting among different portions of the object for placement of the design element (col. 8 lines 53-60).

Claim 9: Knight teaches said object is a cap having a crown and visor, and said object portions include at least one segment of the crown and the visor (fig. 3B [142a, 144']).

Claim 10: Knight teaches providing a user input for ordering the object with the user selected design element and receiving a user order from said user input for ordering the object with the user selected design element (col. 11 line 38 – col. 12 line 3).

Claim 12: Claim 12 is written as a method and contains the same limitations as claim 3; therefore, the same rejection is applied.

Claim 13: Claim 13 is written as a method and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

Claim 14: Claim 14 is written as a method and contains essentially the same limitations as claim 3; therefore, the same rejection is applied.

Claim 15: Claim 15 is written as a method and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 16: Claim 16 is written as a method and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 17: Claim 17 is written as a method and contains the same limitations as claim 9; therefore, the same rejection is applied.

Claim 18: Claim 18 is written as a method and contains essentially the same limitations as claim 10; therefore, the same rejection is applied.

Claim 19: Claim 19 is written as a computer network server and contains the same limitations as claim 1; therefore, the same rejection is applied.

Claim 20: Claim 20 is written as a server and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

Claim 21: Claim 21 is written as a server and contains the same limitations as claim 3; therefore, the same rejection is applied.

Claim 22: Claim 22 is written as a server and contains the same limitations as claim 4; therefore, the same rejection is applied.

Claim 23: Claim 23 is written as a server and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

Claim 24: Claim 24 is written as a server and contains the same limitations as claim 5; therefore, the same rejection is applied.

Claim 25: Knight teaches said computer network is the Internet (col. 4 line 63 – col. 5 line 1).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

- Homma et al. (U.S. Patent No. 5,383,111) that teaches a merchandising system for conducting a control of article display positions that are generally changed by the customers includes a method of obtaining article display positions based on the present display state.
- Arnold et al. (U.S. Patent No. 6,016,504) that teaches a method for establishing and maintaining a virtual outlet ("VO") relationship on the Internet between an entity that controls and manages a Web site constituting a VO and a merchant that controls and manages a different Web site. The VO presents a series of VO Web pages to

customers that contain descriptive information about products from one or more merchants.

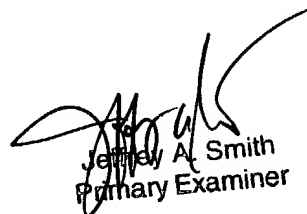
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT

07/13/2004


Jeffrey A. Smith
Primary Examiner